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By: Ruth Montalvo  
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Date: January 25, 2001



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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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BOARD OF PATENT APPEALS AND INTERFERENCES  
U.S. PATENT AND TRADEMARK OFFICE

Customer No. 026418

Docket No. DRAGO P-86RE / 500354.20005

Applicant(s): Marcello TONCELLI

Serial No.: 09/369,570 Group: 1733

Filed: August 6, 1999 Examiner: J. Aftergut

For: A PROCESS FOR THE PRODUCTION OF REINFORCED SLABS OF STONED MATERIAL

Assistant Commissioner for Patents  
Washington, D.C. 20231

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**APPEAL BRIEF PURSUANT TO 37 CFR 1.193**

Sir:

In response to the Examiner's advisory action mailed December 4, 2000 in connection with the above-identified application and the appeal filed on November 27, 2000, Appellants submit this Appeal Brief.

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### REAL PARTY IN INTEREST

The real party in interest is Marcello TONCELLI, the sole inventor of the subject matter of the above-identified application which is not assigned to any other entity.

### RELATED APPLICATION AND INTERFERENCES

There is no other related appeal(s) or interference(s) known to the appellant, the appellant's legal representative or assignee (no assignee) which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### STATUS OF CLAIMS

The claims in this application are claims 1 to 38.

Claims 1 to 7 and 14 to 20 are allowed.

Claims 8 to 13 and 21 to 38 are rejected; and, claims 8 to 13 and 21 to 38 are being appealed

### STATUS OF AMENDMENTS

All of the proposed amendments were entered. There are no further amendments.

### SUMMARY OF THE INVENTION

The invention is concerned with floor coverings and linings for the external and interior parts of a building which include natural stones such as marble and granite.

The invention provides for a stone slab which has a thickness of less than 10 mm. Heretofore, slabs having a thickness of less than 10 mm were not able to withstand machining operations, such as sizing, smoothing, polishing or chamfering, etc.

Another drawback or deficiency with the prior art is that natural stones usually do not possess homogenous physical properties, with respect to their impact strength and flexural strength.

Large size panels, primarily intended for the external facades of buildings are subject to breakage due to gusts of wind, seismic tremors or local disturbances which causes detachment of fragments of a significant size with their obvious dangers.

The prior art has attempted to apply to the rear face or non-viewing face of the slab, reinforcing elements in the form of metal, glass-fiber, or plastic grids which are fixed to the rear surface or reverse face of the slab.

It has been found that technologies in the prior art which use a regular grid formed by grooves or recesses on the rear face and which anchor a reticular element by means of a binder, was not suitable; or by flaming the slabs or tiles with a reinforcing element consisting of plastic material applied so as to reinforce the slab or tile in regions where parts are most likely to be damaged or subject to deterioration during subsequent machining operations are also unsuitable.

Slabs made using the prior art technologies suffer from the problem of differences in expansion and contractions due to ambient conditions because of differences in the thermal coefficient of expansion between the stone material and the resin used as a bonding agent. This drawback was not expected, since there was no expectation that a slab of granite material itself and the layer of resin adhering to the rear face of the granite would have such differences in their individual thermal expansions that the slab would become warped, thereby destroying its usefulness.

The present inventor after much work discovered that the aforementioned problem could be overcome, if not eliminated by impregnating a plurality of glass fibers in the form of non-twisted strands with a percentage ratio of glass strands to resin of at most 50:50, and

preferably with a prevalence of glass strands compared to the resin, see column 2, lines 60 to 67 of U.S. Patent No. 5,670,007.

While the general requirement is to refer the specification (as filed) by page and line number and to the drawings by reference character, since this application is for a Reissue Patent, and the specification is substantially frozen, reference will be made to the Patent No. 5,670,007 as granted.

### ISSUES

1. Whether claims 21 to 38 rejected under 35 U.S.C. 251 is an improper or impermissible recapture of subject matter alleged to have been surrendered in the application for the patent upon which the present reissue is based.
2. Whether a broadening aspect is present in the reissue which was not present in the application for patent.
3. Whether the narrow scope of the claims in the patent was an error within the meaning of 35 U.S.C. 251.
4. Whether the material surrendered in the application for the patent can be recaptured in the present reissue application.
5. Whether the material surrendered in the patent is of broader scope.
6. Whether material in parenthesis forms the basis for the reasons for allowability and whether material in parenthesis can be excluded from a consideration of the specific reasons for allowability.
7. Whether reissue claims 21 to 35 are unpatentable over E.P. 255,795 in view of Japanese Patent 3-247852, optionally further taken with Japanese Patent 6-64076.

8. Whether original claims 8 to 13 which are dependent directly or indirectly on allowed claim 1 can be held to be unallowable for reasons other than being unallowable under 35 U.S.C. 112.

9. Whether original patent claims 8 to 13 and reissue claims 26 to 38 are unpatentable over E.P. 631,015 in view of Japanese Patent 6-64076, Japanese Patent 3-247852 and E.P. 255,795.

10. Whether the reissue claims are broader because they do not include the limitations relating to the rear of the stone material being free of grooves or recesses and does not require the placement of an additional reinforcement between the non-twisted linear members and the slab.

11. Whether the reissue claims are substantially narrower when related to the hardening of the resin.

12. Whether E.P. 255,795 in Figures 9, 11, 12 and 13 and the description of the slab specifically teach that the surface of the slabs are flat or have a smooth face or both.

13. Whether Japanese Patent No. 3-247852 teaches a plaster resin or thermosetting resin to impregnate the reinforcement.

14. Whether it is a distinction if the fibers are in the resin before or after association with the stone slab.

15. Whether the provision of multiple layers is within the purview of the ordinary artisan.

#### GROUPING OF CLAIMS

1. Claims 21 to 38 were grouped together by the Examiner, and it will be pointed out in the argument, why the claims do not stand or fall together.

2. Claims 21 to 25 were grouped together by the Examiner and the claims do not stand or fall together.
3. Claims 8 to 13 and 26 to 38 were grouped together by the Examiner and the claims do not stand or fall together.
4. Claims 8 to 13 form Group I.
5. Claim 21 forms Group II.
6. Claims 22 and 23 form Group III.
7. Claims 24 and 25 form Group IV.
8. Claims 26, 27, 32, 33, 36 and 37 form Group V.
9. Claims 28 to 30 form Group VI.
10. Claim 35 forms Group VII.

#### REJECTION 1

Claims 21 to 38 were rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

#### REJECTION 2

The application was objected to under 37 CFR 1.172(a) as the assignee has not been established its ownership interest in the patent for which reissue is being requested.

For the sake of the record, there is no assignee of this application.

#### REJECTION NO. 3

The amendment submitted 4-21-00 where the claims were amended is not in proper form. This matter is now moot and as indicated in the advisory action of December 4, 2000, places the amended claims in proper form in the reissue application.

REJECTION NO. 4

Claims 21 to 25 were rejected as being unpatentable over E.P. 255,795 in view of Japanese Patent 3-247852, optionally further taken with Japanese Patent 6-64076. The Examiner referred to the same reasons as expressed in Paper No. 2, paragraph 5.

REJECTION NO. 5

Claims 8 to 13, and 26 to 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over E.P. 631.015 in view of Japanese Patent 6-64676, Japanese Patent 6-64076, Japanese Patent 3-247852 and E.P. 255,795 for the same reasons as expressed in Paper No. 2, paragraph 6.

ARGUMENT

With respect to Issue No. 1, applicant respectfully dissents from the Examiner's opinion and argument regarding the broadening aspect of this reissue application and the narrowing aspect.

Considering the Examiner's statement that:

"The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application."

The Examiner then concludes with the following statement:

"Accordingly, the narrow scope of the claims in the patent was not in error within the meaning of 35 U.S.C. 251, . . ."

It is questionable as to how the Examiner knows the state of mind of the inventor and his attorneys in claiming the invention. The Examiner then goes on and states the following:

". . . and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of this application."

The situation differs from the manner in which the Examiner has expressed it. Specifically, the claims have been broadened according to the Examiner in one respect, but clearly narrowed in another respect.

It is perhaps best to start with the Examiner's statement in the patent application with respect to reasons for allowability, and for this purpose, **Exhibit 1** is page 2 of the Notice of Allowance and Issue Fee Due (dated February 19, 1997) from the patent application. The reasons for allowability are clearly set forth in paragraph 1.

Turning now to Claim 21 in the Reissue application, this claim, which is the broadest reissue claim, omits the following recitation from the parent claim or original claim 1 of the Patent -- free from grooves or recesses--, and claim 1 as allowed included this recitation, but it is not and was not a feature or a limitation for which the Examiner indicated reasons for allowance. It is patently evident that the Examiner clearly recognized this because if the notice of allowance of February 19, 1997 is considered and carefully analyzed, it will be noted that the statement "--where rear face of the stone material was substantially smooth and free from grooves or recesses--" was contained within parenthesis and therefore could just as well have been omitted from the reasons for allowability because terms within parenthesis can be omitted without changing the meaning of the clause or statement. Moreover, the reasons for allowability were carefully set forth by the Examiner as follows;

--None of the prior art of record teaches disposing a reinforcing layer between the linear reinforcing elements and the rear face of the slab of stone material (material in parenthesis omitted). Since applicant and then applicant's attorney interpreted the reasons for allowability as excluding extraneous material in parenthesis, there was no reason to contest the Examiner's statement.

The Examiner's statement justifies the limitations in the clause for allowability and patentability purposes when claim 1 is read, and considering the prior art as applied.

It is well settled that a reissue claim is allowable if it is narrower in scope than the original application so that it escapes the recapture rule entirely. This is the exact situation in the present application, claim 21 is narrower than claim 1.

Attention is directed to *B.E. Meyers & Co. v. United States*, 56 US PQ 2d 1110 (US Ct. Fed. Cls 2000).

A party may broaden its patent while applying for a reissue claim. The law does not, however, permit attempts to recapture subject matter affirmatively surrendered during the initial patent prosecution, particularly where the purpose of surrender was to distinguish the claimed invention from the prior art. *See Mentor Corp.*, 998 F.2d at 995-96.

If a reissue claim broadens a patent in a way that does not attempt to recapture what was surrendered earlier, the recapture rule does not apply. *See Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996 [27 USPQ2d 1521] (Fed. Cir. 1993).

Re-examined claims for resorbable bone screw do not violate "recapture rule" by omitting express limitation that starting material for screw be in nonfibrilar state, since original patent does not claim that starting polymer must be nonfibrilar in its entirety, since re-examined patent is narrower than original, in that it limits specific type of claimed device to screw, and specifies strength of device and particular polymers to be used, and since claim that is narrower in scope than original application escapes recapture rule entirely.

Now, it is necessary to consider new claim 21 and the claims dependant thereon which were submitted in the Reissue application. The reasons for allowability apply to claim 21 as well. There is no mention of the statement which appears in parenthesis in reasons for allowance. Claim 21 does not claim any surrendered subject matter.

Reference is made to Webster's Third New International Dictionary, Page 1641, page copy enclosed, **Exhibit 2** which provides the following definition of --parenthesis--:

1a: An amplifying or explanatory comment inserted in a passage to which it may be grammatically unrelated and from which it is usually set off by punctuation (as curved lines, commas or dashes....

1b: A remark or passage that constitutes a departure from the theme of the discourse:  
Digression

2: ...

3a: .....----compare BRACKET 4a

Note also the meaning of "parenthesize"

1: to make a parenthesis of " to interject as comment or digression

2: ...something in parenthesis.

The Examiner's main point is that applicant is trying to recapture subject matter which was surrendered in the patented file and such is not a proper reissue application. Clearly, applicant respectfully dissents.

In the originally filed application two problems were contemplated. It was clearly stated that the inventor was facing two specific situations, namely those in which the strength of a thin slab of natural stone (marble or granite for instance) had to be increased enough to permit the use thereof to overcome the intrinsic fragility due to the too high thinness, and those in which the final slab was to be used in cases of heavy duty, such as for instance for suspended floorings or outer wall coverings.

In the first case, according to the invention the rear face of the slab is provided with the reinforcing layer of non-twisted linear glass fibers impregnated with a hardenable resin.

In the second case, the rear face of the slab is reinforced according to the cited prior art by means of grooves provided in the rear face and housing the reinforcing elements and preferably a hardenable resin, and then the reinforcing layer according to the present invention is added.

In this particular case, and with specific reference to the original patent, no mention is made in claim 1 of grooves or recesses, and then claim 8 adds the formation of grooves or recesses on the rear face of the slab, and the reinforcing elements are housed in the grooves or recesses.

The reasons for allowability takes this clearly into consideration, because if the material in parenthesis is or was essential, then the Examiner would not have allowed claim 1 without the limitations of claim 8. Further, the Examiner also would not have allowed claim 9 which incorporates all of the limitations of claims 1, 8 and 9. Either the reasons for allowability have to be interpreted as not including the reasons in parenthesis or if the reasons must include the statement in parenthesis then claim 1 is too broad. Applicant does not believe it is too broad, and considers it to be allowable as does the Examiner.

Then the Examiner must consider his own decision with respect to claims 9 to 13, which specifically restrict claim 1. If the statement or clause "free from grooves or recesses" is an essential feature or limitation of claim 1 and claim 21 as the Examiner contends, then claims 8 to 13 would not have been considered. But, since they were considered, then the material in parenthesis was not the "reason for allowability", and since the original statement without the material in parenthesis was satisfactory, there was no need for applicant to contest or modify what the Examiner stated. The matter of the prior art rejection of claims 8 to 13 will be dealt with subsequently.

In the original prosecution of the parent application claim 9 was specifically amended to add the grooves and recesses. Note, that claim 7 of the originally filed parent application, read as follows:

7. The process according to claim 5 including inserting linear metal reinforcing elements between said reinforcement and the rear face of the slab.

Note that while claim 7 was dependent on claim 5, the subject matter of claim 5 remains in its original form.

To distinguish from the prior art combination of references, the argument is very clear and reads as follows:

"Claim 1 was also amended to include the subject matter of claim 7, and the additional limitations of hardening of the resin both which limitations clearly distinguish new claim 1 from the combination of references . . . and the additional limitations of hardening of the resin both which limitations clearly distinguish new claim 1 from the combination of references . . . (emphasis added)"

For claim 1 of the parent application, original claim 7 was added to claim 1 during prosecution of the original or basic application; and, this is the limitation to which the Examiner referred in the reasons for allowance.

The second limitation added was the "hardening of its resin", and this limitation is also contained in claim 21 added in the Reissue application.

Now, comparing claim 1 and claim 21, the first feature in claim 1 includes: "free of grooves or recess", (which was not added to distinguish from the references) and claim 21 makes no mention of grooves or recesses.

The Examiner is also taking the comment about the rear face of a slab of stone material out of context. Specifically this comment refers to the first sentence in this paragraph which refers to the amendment of claim 1 to distinguish from natural stone as well as products made of stone material. Claim 1 was not amended to set forth as the Examiner contends that the rear face of a slab of stone material which --is free of grooves or recesses. (emphasis added). The word "this" refers to the amendment of claim 1 in line 2 --products made of --.

It is the contention of the applicant that claim 21 was not broadened out to arrive at a broader claim 1. A careful analysis of claim 21, clearly indicates that this claim includes a

narrowing limitation over claim 1. Specifically claim 1 calls for providing non-twisted linear reinforcing elements.

And, it is not until claim 8, that the linear reinforcing elements are placed or housed in the grooves or recesses.

Now, considering claim 21 and the providing of a layer of non-twisted glass reinforcing elements applied to the rear face. Therefore, new claim 21 is narrower than claim 1 in many respects, and almost as narrow as claim 8. Claim 1 does not specifically place the reinforcing elements on the rear face, and therefore claim 1, is broader than claim 21 in this respect. Clearly, weight must be given to this clear distinction.

The Examiner has also taken issue with the omission of the limitation relating to the inclusion of a reinforcing layer between the coated non-twisted linear reinforcing elements and the rear face of the stone material. While the Examiner indicates that this feature was strenuously argued, applicant respectfully dissents from the Examiner's conclusion or attribution. Moreover, assuming *arguendo* that the Examiner is correct, this argument did not appear to impress the Examiner because the Examiner did not see fit to include this argument in the reasons for allowability. And, applicant did not ask for a modification of the reasons for allowability to include this feature.

In the "original application" evidences were given in the form of the data relating to the mechanical properties of the reinforced slabs with respect to the first mentioned embodiment, because the dramatic increase of these properties (flexural strength and impact strength) lacking any other reinforcing provision was considered the best demonstration that an invention had been made. Of course in the case of the other (namely "heavy duty") embodiment was considered unnecessary.

The Applicant has never indicated his willingness to abandon either of the above-mentioned embodiments.

In the allowed main claim of the parent application and claim 1 of the issued patent, the sentence or limitation "inserting a reinforcing layer between the coated non twisted linear reinforcing elements and the rear face of the slab of stone material" would make no sense, since in the case of the first mentioned embodiment nothing is being inserted between the rear face of the slab and the reinforcing layer consists only of non twisted glass fibers and hardenable resin, and would be contradictory in the case of the "heavy duty" embodiment since the preamble of the claim would exclude any case in which the rear surface of the slab is not smooth and free from grooves and recesses, but in this case the reinforcing layer being inserted would be (as taught in the specification) that consisting of grooves containing linear reinforcing elements and possibly resin.

As a matter of fact this situation is clearly faced by the wording of claim 21.

The Examiner has noted page 7 of the response dated December 23, 1996 and applicant's argument over Toncelli '015. This is a description of applicant's own prior art and applicant's further distinction over his own prior art. It is the inclusion of the subject matter of a former claim 7 into claim 1, and claim 7 (cancelled after claim 1, was amended) referred to the insertion of this metal reinforcing elements between the reinforcement and the rear face of the slab. Note claim 7 was originally appendant to claim 5, but the claim 5 limitation was never added to claim 1.

It appears to be the Examiner's position that because the language the Examiner selected to allow the original application is the reason that applicant should be denied the Reissue claims. However this is not what the Reissue Statute requires.

Reference is made to Bionx Implants Inc. v. Biomet Inc. 54 USPQ 2d 1076. This case holds that a "claim that is narrower in scope than the original application escapes the recapture rule entirely. In this case, an express recitation in the reissue claim was omitted. Specifically, the claim and application were concerned with an express limitation (which was

omitted) that starting material for screw be in nonfibular state, since original patent does not claim that starting polymer must be nonfibular in its entirety, and since reexamined patent is narrower than original, in that it limits specific type of claimed devise to screw.

Reference is also made to Ball Corp. v. United States 799 F. 2d 1429, 1436 [221 USPQ 289] (Federal Express delivery, Cir. 1984) which held that a reissue claim that is narrower in scope than the original application escapes the recapture rule entirely.

In applying the recapture rule of 35 U.S.C. ¶251, the Examiner should (determine) consider the following:

- (1) whether and in what aspect the reissue claims are broader than the original patent claims;
- (2) whether the broader aspects of the reissued claims relate to surrendered subject matter; and
- (3) whether the broader claims are an attempt to recapture impermissibly, limitations that were surrendered in order to overcome prior art rejections.

In all aspects, the reissue claims in the present application are free from the above-noted defects or objections.

Reference is also made to United States Fuller Corp. v. Ionics, Inc. 53 USPQ 2d 1072, which also sets forth the required steps in applying the "recapture rule" of 35 U.S.C. ¶251.

In this case, the substitution of the word "secured" in claims of reissue patent for the word "bonded" did not violate the recapture rule even though "secured" is broader than "bonded" since no changes made in application for original patent to overcome prior art involved the word "bonded" since no changes [were] made in application for original patent to overcome prior art involved word "bonded", and therefore nothing surrendered during

prosecution of that patent relates to "bonded" and since changes from "bonded" to "secured" thus cannot be impermissible recapture.

Basically, the "recapture rule" prevents a patentee from regaining through reissue the subject matter surrendered during the prosecution of the original patent in an effort to obtain allowance of that original patent. What is omitted from claim 21 was not surrendered during prosecution.

The only change that the Examiner disputes is -- free from grooves or recesses -- see last line on page 2 of the Office Action, but this was not specifically added to claim 1 to distinguish over or from any prior art, and the Examiner in his reasons for allowability does not include this as an essential limitation. If applicant is wrong then the attorney did not understand the Examiner, and the Examiner should not have used a qualifier which can be omitted. The Examiner is not considered wrong, and the term in parenthesis could just as well have been omitted.

Furthermore, no substantive changes were made in the original claims (in the reissue as filed) 1 to 20 so as to have them issued in the reissue application.

A careful examination of the prosecution history clearly indicates and demonstrates that the broader aspects of the reissue claims do not relate to any surrendered subject matter, and the reissue claims are not an attempt to impermissibly recapture limitations surrendered in order to overcome any prior art rejection.

It should be noted that an important feature in common with the claims of the original patent and the Reissue claims is that there is a layer of non-twisted glass reinforcing elements. This was argued and pointed out in the specification.

Reference is made to the citation of Hester Industries, Inc. v. Stein 46USPQ 2d 1641 (hereinafter "Hester"), and clearly while this case does indicate that the grant of reissue claims that are broader than original claims, it also indicates that this pertains to the surrender

of subject matter during the prosecution of the application. Further, with respect to Hester, this case held that the reissue claims which are broader in certain respects than the claims of the original patent had not been materially narrowed in other respects so as to avoid the operation of "recapture rule". In this regard, applicants specifically wish to point out that while the claims, specifically claim 21 may have been broadened according to the Examiner in one respect, it has been narrowed in another respect, and the narrowing in the other respect was never clearly given up during prosecution of the parent or original patent.

Also, the material removed from claim 1 to arrive at claim 21 was never added to distinguish from any prior art in the parent application. Note that applicant at all times does not consider the omission of the words in parentheses to be a broadening. As noted in the reasons for allowability, the portion of the claim referred to by the Examiner in his reasons for allowability, is now included in claim 21. All that was omitted from claim 21 is the material in parentheses which the Examiner clearly indicates is not part of the reasons for allowance.

Clearly, the situation of the present application differs from Hester because if the Examiner is correct, then the undersigned attorney did not appreciate the full scope of the invention during the prosecution of the original patent application, and further, applicant's attorney was then mislead by the Examiner's statement regarding allowability because no other reason for allowance was included in such statement. And the reasons for allowability would also pertain to the claims presented in the reissue application for the first time. Limitations are not being removed, but a different aspect of the invention is being claimed. Perhaps, what the Examiner may consider a broadening is really a claim directed to a different, unclaimed invention which applicant had a right to claim when the application was filed, and due to an oversight did not claim. If a different invention is the Examiner's position, then the Examiner should require a division. In Hester, which is different from the

present application, the claims are broader, but not narrower, in the present reissue application the claims are broader in some respects because an unimportant recitation was omitted, but extremely narrow in other respects. Looking at the prosecution history, as noted above, it is clear that the material does not relate to surrendered subject matter.

Hester clearly sets forth that the applicant in that case repeatedly argued during prosecution of the original patent that certain limitations distinguish the original claim from prior art and that each of these limitations was critical to patentability, and since these repeat arguments constitute admissions by applicant, additional limitations were necessary to overcome the prior art. Clearly, in the present case, no such arguments were made. Explanations were made but no arguments were made to support a limitation which is necessary in any of the reissue claims 21-38 of the reissue application.

This case, the Hester Industries case, on page 1648 refers to In re Weiler, et al. 229USPQ 675 to indicate that the reissue statute is based on fundamental principles of equity and fairness and should be liberally construed. Clearly, the applicant in the present application did not give up anything, the applicant just did not claim the invention in all the different ways he was able to claim it. The application SN 08/513,687, now U.S. Patent No. 5,670,007 also did claim the invention all the different ways the invention could be claimed.

With respect to In re Clement 45USPQ 2d 1161 (Fed. Cir. 1997) it should be noted that this case held that the recapture rule applies to reissue claim to prevent obtaining such a claim, if it is as broad as or broader than a canceled or amended claim in all respects; note the term "all". If the reissue claim is narrower in all respects the recapture rule does not apply, but other rejections are possible. Clearly, if there is an aspect in which the Reissue claim is narrower, then the reissue claim is not broader in all (emphasis added) respects. In the present situation, it is respectfully submitted that the recapture rule does apply because the new reissue claims 21-38 are not broader in all respects than any previous claim on file

during the prosecution of the original parent application. Recapture rule does not apply if claim is broader in respect of a matter non-canceled during prosecution.

Therefore, claims 21 to 38 are directed to subject matter which is a proper and permissible recapture of subject matter which could have been claimed in the parent application and was not, and further was subject matter which was not surrendered in the parent application.

There is no broadening aspect in the present reissue application which was not present in the parent application for patent. This is clearly evident from a consideration of the prosecution history as supplemented by the "reasons for allowability".

Further, the narrow scope of the claims in the patent was an error within the meaning of 35 U.S.C. 251 as clearly evident from the specification of the patent and the declaration of the reissue application.

Based on the foregoing, material in parenthesis do not form a basis for the reasons for allowability, and further material in parenthesis are excluded from a consideration of the specific reasons for allowability because as well know a statement with material in parenthesis can be excluded from the statement without changing the meaning of the statement.

Consequently, in conclusion, the broader scope, if any, surrendered in the application for patent can be recaptured in the present reissue application, and the applicant is entitled to such recapture.

With respect to the claims rejection, it is respectfully submitted that since claim 1 is considered to contain allowable subject matter, and claims 8 to 13 which are either directly or indirectly appendant to claim 1, then claims 8 to 13 should be considered to be allowable unless there is an objection under 35 U.S.C. 112, and there has been no objection under 35 U.S.C. 112, claims 8 to 13 are to be considered to be allowable.

Turning now to the rejection of Claims 21-25 rejected under 35 U.S.C.103(a) as being unpatentable over EP 255,795 in view of Japanese Patent 3-247852 optionally further taken with Japanese Patent 6-64076, for the reasons set forth in the sub-paragraphs 2, 3 and 4.

A basic feature distinguishing this invention from the prior art taken either singly or combined in any valid combination which was full surprising for the inventor, namely that the glass fibers should be of **non-twisted** nature. This fact is also very useful as regards the prior art being applied by the Examiner. And, it indicates that no one was aware of what could be done with applicant's combination.

Furthermore, the Examiner clearly admits that EP '795 fails to teach the specific amount of resin in the reinforcement. The specific amount of resin is an essential feature of the invention; this feature was always included in the claims as originally filed. And, it is specifically included as a limitation in reissue claim 21.

The Examiner then refers to Japanese '852 to indicate what an ordinary artisan knows and understands. Applicant has had a translation of part of Japanese Patent '852 prepared, and a copy was sent to the Examiner. Pages 2 and 3 were specifically brought to the Examiner's attention wherein it is stated that the reinforcing of thin slabs of natural stone by means of FRP layer containing chipped strand is not satisfactory and for this reason in this prior reference recourse is made to a rather complex reinforcing structure consisting of multiple layers.

The Examiner's response refers to Figures 9, 11, 12 and 13 of EP '795 and answers a different issue. A limitation in claim 21 is that the slab of stone material is provided with a rear substantially **smooth face**. The basis for the Examiner's rejection is on the one hand:

- (1) the surface of the slabs were **flat**; and
- (2) appear to be smooth - in parenthesis.

It is not understood whether this is derived from the Examiner's personal experience or whether this is gleaned from the drawings. Again, the Examiner uses parenthesis for item (2); does this mean that they appear from the drawing or from some disclosure.

There is a clear technical and structural difference between "flat" and "smooth".

Clearly, there is no clear teaching of this feature.

Then the Examiner goes into what an ordinary artisan would know. According to the Examiner, -- the ordinary artisan would have expected that thin layers of slab material would have been flat and smooth subsequent to the cutting operations -- . This is only derived from the teachings of applicant's specification.

The Examiner is using a draftsperson straight line to argue that a surface is flat, but not smooth. An examination of the detailed description and claims makes no specific mention that the surface is "substantially smooth." More specifically, a surface may be physically flat as viewed, and yet not be "substantially smooth".

The Examiner again tries to reconstruct the claim 21 by changing the meaning of a limitation. The Examiner did not provide a translation of Japanese Patent 3-247,852, and a translation is provided at Exhibit 3.

Please note that on pages 2 and 3 of the English translation of Japanese '852, there is the statement that -- the reinforcing of the thin slabs of natural stone by means of a FRP layer containing CHIPPED STRAND is not satisfactory and for this reason in this particular prior art reference, recourse is made to a rather complex reinforcing structure consisting of multiple layers. A clear teaching away from the present invention.

Consequently even with the prior art cited by the Examiner, it is demonstrated that the use of non-twisted glass fibers by which the problem encountered is solved was fully unexpected in view of the common knowledge in the related art.

The Japanese '852 patent is primarily intended to provide strength and bendability. This is not the purpose of applicant's invention. In fact, the '852 patent teaches away from the teaching of applicant's invention. Therefore, no modification of EP'795 with the Japanese '852 comes even close to the teachings of applicant's claimed invention.

With respect to Japanese '076, it is the Examiner's belief that one skilled in the art would have applied the longitudinal, non-twisted reinforcement against the stone panel, the Examiner's belief or conjecture is not sufficient. Applicant has a claim which is restricted to the features set forth in the claim. A piece-meal selection of isolated features is made from a number of different patents, and combining these features without a showing of any motivation. The Examiner still opines that one skilled in the art would add features not disclosed, nor suggested, not taught in the prior art, regardless how the disclosure of the patents cited references are expanded.

Note, Claim 1 included a clause which provides that the rear face of the stone material was substantially smooth and free from grooves or recesses, but it was never added to distinguish from the prior art, as will be explained.

Claims 8-13 and 26-38 were rejected under 35 U.S.C. 103(a) as being unpatentable over patent EP '015 in view of Japanese '076, Japanese '852 and EP '795. As noted heretofore, claims 8 to 13 are dependant on an allowed claim and therefore are considered to be allowable.

Specifically, the rejection can not apply to Claims 26 and 27 because these claims do not include the limitation of grooves or recesses, and only claims 28, 29 and 30 refer to grooves or recesses. Therefore, EP '015 is to be removed from the rejection as a basic reference. With respect to Japanese '076, and considering this patent with respect to Claims 28, 29 and 30, and Claims 8-13 of the original patent.

The basic patent EP '015 is the applicant Toncelli's own patent, and the present invention is an improvement thereover. In effect what the Examiner is saying is that prior to June 25, 1993, Mr. Toncelli should have been aware that it was obvious to do what is claimed in Claims 8-13 and 26-38. However, the '015 patent did not satisfy the requirement and the specification in the preamble takes this into consideration particularly if the Examiner and this honorable Board will consider column 2 lines 37 - 44. Note, line 52-57 and the material contained therein. No declaration from Mr. Toncelli, who is the inventor of the particular patent cited as well as this application is necessary, to substantiate the statements made in this patent because the application was signed under a declaration in view of an oath. The mere fact that Mr. Toncelli signed the original patent documents attests to the validity and proof of this statement made. Therefore, even with Claims 28, 29 and 30, this patent should be removed as a basic patent. With removal of the basic patent, there is no suggestion or teaching in any of the other prior art how applicants earlier patent can be modified.

Therefore, all of the claims now in the application are clearly and patentably distinguished from all the references cited by the Examiner taken either singular or combined in any valid combination.

Appellants respectfully submit that all of the rejections of the final Office Action are improper and should not be sustained by the Board of Appeals.

The Commissioner is hereby authorized to charge any fees in connection with this Reply Brief to Deposit Account No. 50-1529.

This appeal brief is submitted in triplicate.

Applicant respectfully asks that the Examiner be reversed and that a new patent issue with claims 1 to 38.

Respectfully submitted,

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January 25, 2001

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Enclosures: Exhibit 1 (Page 2 of Notice of Allowance and Issue Fee Due)  
Exhibit 2 (Page 1641, Webster's Third New International Dictionary)  
Exhibit 3 (Partial Translation of Japanese Patent 03247852A)  
Check in the amount of \$310.00

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## APPENDIX

### CLAIMS

8. The process according to claim 1, wherein grooves or recesses are formed on said rear face of the slab and said linear reinforcing elements are housed in the grooves or recesses.

9. The process according to claim 8, wherein said grooves or recesses form a grid.

10. The process according to claim 8 including inserting laid down glass fiber yarns between said reinforcement and the rear face of the slab linear reinforcing elements and sealing the laid down glass fiber yarns within the grooves or recesses.

11. The process according to claim 10, wherein said linear reinforcing elements include rods or bars of extruded fibers of glass and resin.

12. The process according to claim 11, wherein said linear rods or bars have a diameter of 2 to 2.5 mm.

13. The process according to claim 11, wherein said rods or bars comprise 68% glass and 32% resin, the percentages being expressed by weight.

21. A process for producing a reinforced slab of products made of stone material, having a reinforcement which includes a hardened resin combined with a rear face of the slab, comprising:

providing a slab of stone material having a rear substantially smooth face,

providing a layer of non-twisted linear glass reinforcing elements applied to the said rear face;

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coating the non-twisted linear glass reinforcing elements with a coating of a resin to form a reinforcement having a percentage ration by weight of resin to the non-twisted linear reinforcing elements of at most 50:50 and hardening of the resin.

22. The process according to claim 21, wherein said layer of non-twisted linear glass elements consists of glass strands.

23. The process according to claim 22, wherein the percentage weight ratio of resin to glass-strands is 33:66, and are in the form of a matting or bundles.

24. The process according to claim 21, wherein said slabs of stone material have a thickness no greater than 10 mm.

25. The process according to claim 24, wherein said slabs of stone material have a thickness between 6 to 8 mm.

26. The process according to claim 21, including inserting further linear reinforcing elements between said reinforcement layer and the rear face of the slab.

27. The process according to claim 26, wherein said further linear reinforcing elements are made of metal, and the metal is steel.

28. The process according to claim 26, including housing said further linear reinforcing elements in grooves or recesses formed in said rear face of the slab.

29. The process according to claim [27] 28, wherein said grooves or recesses form a grid.

30. The process according to claim 27, including inserting, as said further linear reinforcing elements, laid down glass fiber [yams] yarns between said reinforcement and the rear

face of the slab linear and sealing the laid down glass fiber [yams] yarns within [said] the grooves or recesses.

31. The process according to claim 30, wherein said further linear reinforcing elements include rods or bars of extruded fibers of glass and resin.

32. The process, according to claim 31, wherein said linear rods or [barshave] bars have a diameter of 2 to 2.5mm.